

Application Number: 09/396,531

Group Art Unit: 3711

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Examiner Name: William Pierce

Inventors: Randall Addington et al.

Attorney Docket No.: 99-1001

Title: Bowler's Aid

Assistant Commissioner of Patents

Washington, D.C. 20231

A Petition to make Special Under 37 CFR 102(c) has been granted in this Application and

has been granted in parent application 09/130,905, filed 08/07/98

Appellants Appeal Brief

I. The Real Parties In Interest are the Applicants.

II. There are no related appeals or interferences.

III. Claims 1 -31 are pending in this case.

IV. Claims 1 -31 have been finally rejected.

V. An amendment has been filed after final rejection, amending claims 16, 22, 23, 25, and 26, to remove objections and to reduce issues for appeal. It is not known whether the amendment was entered in whole or part.

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VI.

SUMMARY OF THE INVENTION

A finger pad shield has a contact area on a first side for placement of the contact area in contact with a bowler's finger pad. See page 12, lines 23-25, Figure 1, page 13, lines 27 - 28, page 23, lines 14 -15. The finger pad shield is made rigid for distributing the force produced by a maximum natural force lifting the bowling ball upon its release, over

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the contact area in contact with the finger pad. Page 5, lines 1-14, page 8, lines 1-9, page, 13, lines 1 -10, page 22, lines 9-18 page 23, lines 8 - 28, page 24, lines 1-10. The finger pad shield is made rigid or substantially rigid to resist deformation from the maximum natural force produced when lifting the ball in its release. The maximum natural force is within a range limited by a limit of muscular skeletal development. Page 23, lines 23 - 28, page 24 , lines 1- 7. The finger pad shield may be placed in the finger part of a glove. See Fig 3, page 18, lines 1 - 8, and may be a fixed part or removable, page 24, lines 17 - 22. The finger pad shield may have a raised surface extending away from the surface of the finger pad shield, to limit the depth of insertion of the finger pad shield into the bowling ball finger hole. Figure 6, page 21, lines 4 - 23. The finger pad shield may be connected to a rigidly deflectable support to deflect under said force of the bowling ball and to produce a counter force for restoring the support to a stable position. Page 12, page 13 lines 1 - 10, Figure 1.

VII.

ISSUES

1. Whether Claims 1-31 can be rejected under 35 U.S.C. 112 Paragraph 2 being indefinite.
2. Whether claims 15, 17-18, 19-20, 22 and 23 can be rejected under 37 CFR 1.75(c) as being of improper dependent form.
3. Whether claims 1-5, 9-17, 19-23 and 27-31, can be rejected under 35 U.S.C. 102(b) as anticipated by Fowble.
4. Whether claims 6-8 and 24-16, can be rejected under 35 U.S.C. 103 as unpatentable

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over Fowble in view of Pratt.

5. Whether claims 16-17, 19-21, 27-31, can be rejected under 35 U.S.C. 102(b) as anticipated by Marinese.

6. Whether claims 24-26 can be rejected under 35 U.S.C. 103 as unpatentable over Marinese in view of Pratt.

## VIII.

### Arguments 1-6 Made To Examiner's Rejections Restated In Issues 1-6

### THE ADMINISTRATIVE PROCEDURE ACT STANDARD OF SUBSTANTIAL EVIDENCE

### IS INCORPORATED INTO ALL ARGUMENTS MADE IN THIS APPEAL

In all of the Arguments 1 to 6 inclusively, Applicant incorporates the Administrative Procedure Act Standard for a Patent Office rejection that requires a fact based conclusion based on substantial evidence. Dickenson v. Zurko 50 USPQ 2d 1930, 193, and in which asks whether a reasonable mind might accept a particular evidentiary record as adequate to support a conclusion. Zurko, at 1935. See In Re. Kotzab 217 F. 3d 1365 (Fed. Cir 2000) requiring the rejection be "based on particular findings." at 1370. See In Re. Gartside 203 F.3d 1305 (Fed. Cir. 2000) requiring that a rejection be based on substantial evidence meaning "...such relevant evidence as a reasonable mind might accept as adequate to support a conclusion..." at 1312; and that a Patent Office decision, "must explicate its factual conclusions enabling... [the Court...] to verify readily whether those conclusions are indeed supported by 'substantial evidence'...," at 1314) (hereinafter "APA Standard").

#### I. (Argument No.1)

##### Argument No. 1: Reference Issue No. 1, Claims 1-31 can not be rejected under 35 U.S.C.

112 Paragraph 2 as being indefinite, for the grounds asserted by Examiner in Paper No. 8,  
Paragraph 1 and Paragraph 8, page 9 and pages 7-8

A.

The claims do not recite as positive limitations, the bowler's finger or the bowler, or the  
bowling ball

Applicants have claimed their invention as permitted under the rules stated in the MPEP. The applicants are permitted to describe the subject matter which they consider their invention. MPEP §2171. The claim interpretation would be as given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, in view of the content of the application and the teachings of the prior art. MPEP §2173.02. The preamble is not given any weight where it states the purpose of the claimed invention and does not include an essential limitation. MPEP §2171.01, §2171.02. The claims are to a "bowler's aid," which is as shown in the specification and recited in the claims as a finger pad shield or bowler's aid or means for protecting a bowler's finger pad. Inspection of the claims show there are no limitations in the preamble. There are no "positive recitations to the 'bowling ball,'" or to the "bowler" or the "bowler's finger," in the preambles or the recited elements of the claim. Examiner asserts the "bowling ball" is positively recited and notes claim 1 paragraph c, in support of that assertion.

However, as set forth in claim 1, paragraph c recites,

    said second surface for insertion into a finger hole of a  
    bowling ball against the interior wall of said finger hole and  
    for receiving a force of said bowling ball when a bowler's

maximum force is applied by said finger pad to the bowling ball, in releasing the bowling ball.

Paragraph c, of claim 1 recites a functional limitation in the setting of a means plus function claim. A functional limitation as may be used in any claim, whether or not a means plus function claim. It is used to define a purpose or capability of a claimed element. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP 2173.02. In the context of paragraph c, claim 1, the finger pad shield means is recited in terms of its purpose in connection with bowling and that is clear to one skilled in the art possessing the ordinary level of skill in the pertinent art at the time the invention was made, in view of the content of the application and the teachings of the prior art. The prior art indicative of the knowledge of one skilled in the art is as described in Section II., B, below and as shown with reference to the patents cited therein. It is clear to one skilled in the art in view of the content of the application and the teachings of the prior art, the context of the claims, the claimed invention as recited does not claim the combination of the "bowler" or the "bowler's finger" or the "bowling ball."

An example of similar language to the recited claims in this application and acceptable as used in the claims to a bowling apparatus, and not viewed as claiming the bowling ball or the hand or wrist of the bowler or any part thereof, is shown in Patent 4,371,163 and Patent 3,046,561, where the claims recite the "curvature of the bowler's thumb," "the joint between the thumb and the hand," "the outer side of the thumb above the knuckle," and "thumb opening of the bowling ball, for Patent 3,046,561, and

"bowler's hand," "bowler's forefinger," "a hand covering portion," "wrist covering portion," "the wrist," "the base of the little finger," "the base of the forefinger," and "the bowler's forearm," for Patent 4, 371, 163. Examiner fails to support by fact as required by the APA Standard, his assertion about "positive recitations to the 'bowling ball,'" or "bowler's finger," or give reasons based on fact why he believes "the bowling ball is being claimed in combination with the finger shield," or how "the ball is functionally recited in the preamble..."

Examiner's statement, "...the claim positively recites 'the bowler' and 'said bowler's finger,' implying that such is also being claimed in combination....," is not clear as to which claims he means or the particular claim recitations found improper under 35 U.S.C. 112 and because of the ambiguity in Examiner's statement, Examiner has not complied with the APA standard, denying Appellant a fair opportunity to traverse the ground of rejection. However, for the purpose of completing the Brief, Appellants accept that statement is applied against all claims 1-31, and reapply the arguments made above, without accepting that statement of Examiner as properly made under the APA Standard.

B.

Claims 17 and 20 are not indefinite

Examiner has rejected claims 17 and 20 as indefinite on the ground,

"one cannot determine what the range [of the force] may be."

See Paper No, 8, Paragraph 1, lines 11 - 16.

However, Examiner's representation of the claims is contrary to the claim recitations and critical to the error in the rejection. For example the "force" is recited in claim 16, in

relation to "said means for protecting a bowler's finger pad," as

protecting said bowler's finger pad from a force of a bowling ball produced from a maximum natural force for lifting said bowling ball in the release of said bowling ball,

and in claim 17 as,

said maximum natural force is within a range limited by a limit of muscular skeletal development.

The recitations of claim 16 and 17, for example refer to a maximum natural force limited by a limit of muscular skeletal development, and not to

*the maximum natural force of an individual bowler limited by that individual bowler's limit of muscular skeletal development.*

Accordingly, Examiner's remarks about each individual's strength or technique is irrelevant to the recitation, a maximum natural force limited by a limit of muscular skeletal development. The recitation of claims 16 and 17 are not dependent on, or limited to, an individual's muscular skeletal development but only on a limit of muscular skeletal development. Claim 16 and 17 should not be read with this "individual" restriction, as placed in the claims by Examiner and which is not part of the specification. This Examiner placed claim restriction changes the meaning of the claims from a general limit of muscular skeletal development and definable as a range, as explained below, to an individual limit of muscular skeletal development. When a term of degree is used such as in a maximum natural force or maximum natural force is within a range limited by a limit of muscular skeletal development, first a determination is to be made as to whether the specification provides some standard for measuring that degree. If it does not, a determination is made as to whether one of ordinary skill in the

art, in view of the prior art and the status of the art, would be nevertheless reasonably appraised of the scope of the invention. MPEP § 2173.05(b).

The term maximum is a term of degree, implying a range up to a maximum force. The specification provides a standard for that range. See specification page 23, lines 14 to end and page 25, lines 1-7. See Declaration made under 37 CFR 1.132 by Dr. W. Robert Addington, DO, a Board Certified Physician in Rehabilitation Medicine and an expert in musculoskeletal medicine traversing the objections made by Examiner from his own personal knowledge. In his Declaration, Dr. Addington states for example, “[t]here is a limit to muscular skeletal development and a maximum force with respect to the limit of that muscular development.” That “maximum” force as recited in the claims, is a sufficient standard for a range up to that “maximum.” Examiner’s argument based on an “undefined individual,” is irrelevant to the claim recitation, which is not restricted to any individual and where the “maximum” force can be determined by the general standard of the “limit of maximum muscular skeletal development.” See specification, page 23, lines 27 - 28.

The claim recitations rejected by Examiner, and as stated above, are consistent with acceptable practice when implicitly or implicitly reciting a range as for example in Patent 3,036,561, wherein claim 1 recites,

the outer member being diametrically proportioned to have a free and easy fit within the usual thumb opening of a bowling ball, and its long wall section adapted for frictional engagement under pressure of the thumb.

Another example in that same Patent is in claim 2, reciting,

as the ring is fitted upon the thumb is proportioned to extend

beyond the surface of the bowling ball, and  
outer members are shaped to conform to the joint between  
the thumb and the hand.

Another example in the same Patent is claim 3, reciting, "stable form," "relatively long," "diametrically proportioned to have a free and easy fit within the usual thumb opening of a bowling ball," and "directly above the knuckle to insure the and relating a claim limitation to the anatomy of a bowler.

In Patent 4,371,161, similar implied ranges are as examples are in claim 1, reciting, "a rigid support body," "a layer of resilient material," and "strap means to secure said support body firmly."

C.

Claim 18 is cancelled; claims 25 and 26 have been amended to reduce issues on  
appeal

Examiner is correct with regard to claim 18, and claim 18 has been cancelled by amendment to narrow the issues in this appeal.

Examiner's rejection of claims 25 and 26 is believed to be based on the repeated but not redundant, recitation underlined as it appears in claim 24 reciting: *The bowler's aid of claim 19, including a glove having a finger part and said finger pad shield is attached to said finger part.* Claims 25 and 26 have been amended to remove the issues raised by this repeated recitation and reduce the issues for appeal. However, as presented without amendment, claim 25 clearly limits claim 24 by the recitation, "and said finger pad shield is within said finger part," and claim 26 clearly limits claim 24 by "and said finger pad shield is exterior to said finger part," that Examiner's preferred

action should have been merely to suggest removing the repetitive recitation or changing the dependency. Accordingly, claims 25 and 26 are not contradictory of claim 24 and clearly are in limitation of the recitation, " including a glove having a finger part."

D.

Grounds of rejection unreasonably delayed until the Final Rejection

Examiner is making new 35 U.S.C. 112, 2<sup>nd</sup> paragraph, rejections which he could have made in Paper No. 5 but delayed until Paper No. 8 and has denied applicants a fair chance to amend claims in a Rule 1.111 amendment. Appellants only change to Claim 1, made in its Rule 1.111 amendment was to amend it in accordance with Examiner's suggestion made with regard to the asserted lack of antecedent basis in claims 2 and 5 and relevant to claim 1. See Paper No. 5, Paragraph 2, where the only basis for rejection under 112, 2<sup>nd</sup> paragraph was a lack of antecedent in dependent claims 2 and 5 and a functional recitation in claim 15. Examiner has not rejected claim 1, in Paper No. 8, for the same rejection made in Paper No. 5, and cured by Appellants in their Rule 1.111 amendment. However Examiner has applied a new ground of rejection against claim 1 (see Paper No. 8, page 9 lines 3-17), which could have been made in Paper No. 5, and Examiner has denied Appellants the right to amend the claims in a Rule 1.111 amendment.

E.

Claim 15 is definite under 35 U.S.C. 112

Examiner asserts in Paper No. 8, Paragraph 8, Pages 7-8, the scope of claim 15 is not clear.

Claim 1, paragraph e, recites,

said finger pad shield means is made of a rigid material  
adapted to spread said force of said bowling ball over said  
contact area of said first surface for reducing the pressure  
over said contact area.

(underlining added)

Claim 15, dependent from claim 1, recites,

wherein said finger pad shield means is made to  
substantially resist deformation in said contact area from  
said force of said bowling ball.

The recitation in claim 15 (underlined) is in the context of the function of resisting deformation in the contact area from the force of the bowling ball. That recitation within a means plus function context, fairly conveys to one skilled in the art the structure of the finger pad shield means as made of a rigid material adapted to spread "said force" over the contact area and, as a further limitation, is made rigid to resists deformation from that force. That recitation covers the corresponding structure described in specification and its equivalents. Examiner's question if "it is the material or the structure," is irrelevant and nonsense, as the structure comprises the material and are one in the same, in connection with the recitation of the claim. Support for the structure and its material is in the Specification on page 16, lines 23-28 and page 17, lines 1-2. Examiner's attempt to separate structure from the material of that structure is made without any fact basis and fails to meet the APA Standard.

Appellants have shown the recited "force" is definite within the context of claim 15, dependent from claim 1, (See Section I. B, above.)

To narrate means to recite the details of a story. That definition may be found in any standard dictionary. Examiner's statement the claim is "narrative," is a conclusion without stating Examiner's facts why the claim recitation is "not clear," as would be required under 35 U.S.C. 112, 2<sup>nd</sup> Paragraph. To merely say a claim is narrative is insufficient and fails to meet the APA Standard. Examiner's burden is to show factually, why a claim recitation is not clear or is not properly functional, as permitted under 35 U.S.C. 112, 6<sup>th</sup> paragraph. What something does is that "something's" function. In the context of claim 15, that function covers the structure described in the specification and its equivalents and is clear to one skilled in the art.

An example of similar language to the recited claim 15 "made to" and acceptable as used in the claims to a bowling apparatus, is shown in Patent 3,046,561, Claim 2, reciting,

... and outer members are shaped to conform to...,

or in claim 3, reciting,

...curved to conform to the shape..., or

...diametrically proportioned...".

F.

The claims are written within the accepted practices of the Patent Office

As an example of what is acceptable practice under 35 U.S.C. 112, may be seen

in U.S. Patent 5,484,153, where the claim recites as essential limitations, "selected metal construction material to support the weight of a motorcycle," "The weight of the said motorcycle holds said plate in place," and "said spring urgency contributes to obviating any rattling thereof during riding use of the motorcycle." Such recitations in a structural claim are functional, and imply undefined and unlimited ranges of weights or spring tension or the intended use of the flat plate, without defining structure and within a narrative claim, and in that regard, are no better than Appellants' claims. However these same recitations were accepted in this '153 patent.

## II. (Argument No. 2)

Argument No. 2: Reference Issue No. 2, Claims 15, 17-18, 19-20, 22 and 23 cannot be rejected under 37 CFR 1.75(c) as being of improper dependent form, for the grounds asserted in Paper No. 8, Paragraph 2

Claim 1, paragraph e, recites,

    said finger pad shield means is made of a rigid material  
    adapted to spread said force of said bowling ball over said  
    contact area of said first surface for reducing the pressure  
    over said contact area, and

Claim 15, dependent from claim 1, recites,

    The bowler's finger pad shield means of claim 1, wherein  
    said finger pad shield means is made to substantially resist  
    deformation in said contact area from said force of said

bowling ball.

Claim 15 limits the recitation of claim 1, paragraph 15, by reciting the rigid material recited in claim 1, "is made to substantially resist deformation..."

Claim 16, recites the,

force of a bowling ball produced from a maximum natural force for lifting said bowling ball in the release of said bowling ball, and

Claim 17 recites,

said maximum natural force is within a range limited by a limit of muscular skeletal development.

Claim 17 clearly limits the "maximum natural force" as recited in claim 16.

Claim 19 is an independent claim and Examiner's rejection on the ground of improper dependency is irrelevant.

Claim 20 reciting,

said bowler's maximum natural force is within a range limited by the limit of muscular skeletal development,

limits the recitation in claim 19 of,

said bowler's maximum natural force.

While claim 20 clearly limits the recitation of "said bowler's maximum natural force," to remove an issue for appeal, Appellants have amended claim 20 by removing "bowlers" to recite, "said maximum natural force is within a range limited by the limit of muscular skeletal development."

Claim 22 recites,

said finger pad shield is formed to be substantially rigid to resist deformation and to spread said force of a bowling ball produced by a natural maximum force applied by the bowler's finger pad, over said contact area uniformly, and

    Claim 23 recites,

    said finger pad shield is formed to be substantially rigid to resist deformation and to spread said force of a bowling ball produced by a natural maximum force applied by the bowler's finger pad over said contact area to prevent pressure spots within said contact area.

    (underlining added to show added limitations)

    Claim 22 and 23 limit the recitation in claim 21 of,

    said finger pad shield is formed to be substantially rigid to resist deformation and to spread said force of a bowling ball produced by a natural maximum force applied by the bowler's finger pad over said contact area to prevent pressure spots within said contact area,

    by the limitations shown underlined above. While Appellants travers Examiner's rejection in Paper No. 8, Paragraph 2, Appellants have amended claims 22 and 23 to depend on claim 19 to reduce the issues on appeal.

### III. (Argument No. 3)

Argument No. 3: Reference Issue No. 3, Claims 1-5, 9-17, 19-23 and 27-31, cannot be

rejected under 35 U.S.C. 102(b) as anticipated by Fowble, for the grounds asserted by Examiner in Paper No. 8. Paragraph 3

A.

Examiner's Statement, " the recitations in paragraph c are functional..."

Examiner has rejected claims 1-5, 9-23 and 27-31 under 102(b) as anticipated by Fowble. However claims 1-18 and 31, are written in means plus function language and under 35 U.S.C. 112, 6<sup>th</sup> paragraph, are permitted to be expressed in functional language. Examiner's statement, apparently referring to claim 1, "[t]he recitations in paragraph c are functional..." is irrelevant to claims 1-18 and 31.

B.

Fowble Does Not Anticipate Claims 1-31

A rejection under 35 U.S.C. 102(b) requires the Examiner show in a single reference every element of the claim. MPEP§ 2131, Page 2100-54 Knowledge of One Skilled in the Art. Prior to the filing date of this application, one skilled in the art of bowling knew the conventional method of releasing a bowling ball with rotation down the alley and spin to achieve pin scattering, by inserting (a) middle finger(s) into the ball finger hole, and releasing the ball by placing the ball on the middle finger(s) and applying a first force against the ball through that inserted finger and the ball's finger hole, to lift the ball to rotate and spin the ball and producing a counter second force, as well known by every one who ever bowled and from Newton's commonly known second

law that for every action there is a reaction, See U.S. Patent 4,371, 161, column 3, lines 33 - 65, column 4, lines 1 - 17. See Declarations of R.A. Addington made under Rule 1.132, and submitted with this Application, traversing objections raised by Examiner in the parent application and continuing in this applications and stating what was known to those skilled in the art as of the filing date, and in particular about "lift" applied to the ball in releasing a bowling ball, to impart rotation and spin through the bowler's middle finger.

The knowledge of one skilled in the art reading Claims 1-31 would understand what is meant in the claim by the recitation of a maximum force is applied by said finger pad to the bowling ball, in lifting the bowling ball in the release of the bowling ball. See MPEP §2173.02.

What Fowble does not show and as recited in Claim 1 is the recitations of,

- c. said second surface for insertion into the finger hole of a bowling ball against the interior wall of said finger hole and for receiving a force of said bowling ball when a maximum force is applied by said finger pad to the bowling ball, in releasing the bowling ball;
- d. means for placing, connected to said finger pad shield means, for placing said contact area in contact with said finger pad; and wherein
- e. said finger pad shield means is made of a rigid material adapted to spread said force of said bowling ball over said

contact area of said first surface for reducing the pressure over said contact area.

Examiner is parsing the claim when the claim elements should be examined as a whole. Functional language does not, in and of itself render a claim improper and a functional claim must be evaluated and considered just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP § 2173.02. Functional limitations may be used to define a capability or purpose of an element. Id. MPEP §2173.05(g). Accordingly, the recitations in Claim 1, are properly functional under 112, 6<sup>th</sup> paragraph and define the finger pad shield means in terms of what it does, its capability and purpose.

Fowble is a finger pad limited to use in picking up material which may gall or chafe the fingers, and does not disclose any functions or purpose associated with bowling or as claimed by Appellants.

Claim 2 is rejected as anticipated by Fowble. Claim 2 is dependent from Claim 1 and the limitations of Claim 1 are read with the limitations of Claim 2. Fowble does not show any capability for “locating” the contact area on the finger pad so the force is spread over the contact area. The device of Fowble is limited to an undefined “hardness” intended to reduce wear incident to handling of building material.. See Column 2, lines 60-67. But nowhere in Fowble is there any disclosure of the means and functions as recited in Claims 1 or 2.

Claims 3, 4 and 5 are allowable as dependent from allowable claim 1 (amended).

The disclosure of Fowble does not show a limit means or a raised surface, as

recited in Claim 9,10, and 11. The device of Fowble is limited to picking up building material and not to the functions or structure, purposes or capabilities, as recited and as would be understood by one skilled in the art of bowling. Examiner has shown no factual basis for rejecting these claims except what he can read into Fowble by the hindsight he gains from this Application, or by speculation.

Examiner has not asserted that Fowble shows, and Fowble does not show, a "support means" as recited in claims 12 to 14 or the function recited in means plus function claim 15,

wherein said finger pad shield means is made to  
substantially resist deformation in said contact area from  
said force of said bowling ball.

Claims 16-18 recite elements in means plus functional language not disclosed in Fowble. Examiner reads into Fowble disclosure functions which are not disclosed but only appear to Examiner, in his words as "capable of functioning as a 'limit means...'" This ground of rejection based on what Examiner believes he sees as a capability but which is not disclosed as a "capability," is not proper under 102(b). The same argument is made to Examiner's asserted disclosure of "support means."

Examiner has not explained his grounds of rejection for claims 19-30 or claim 31, written in means plus function language. Examiner has not identified why or how Fowble discloses,

strap 5 is capable of functioning as a 'limit' means or is  
considered a 'raised surface' as called for in claim 10,"

or why or how,

Reference 6 is considered a 'support means' as called for by claims 12-14.

Examiner is required to show by a fact based reference to Fowlbe, where or how Fowlbe discloses Appellants' recited and claimed elements. Examiner has made that showing and Examiner's rejection fails to meet the APA Standard.

If Examiner is making a rejection on the ground of inherency, Examiner is required to show his evidence supporting the rejection. All Examiner has done is state conclusions without reference to the full recitations of the claims. MPEP § 2112.

C.

The prior art is not disclosed as capable of performing the intended use of protecting the finger

On Page 9, lines 1-17, of Paper No. 8, page 9, referring to Fowlbe Examiner states,

...the functional statements of paragraph c. fail to distinguish over the art since the applied art is capable of performing the intended use of protecting the finger while bowling and spreading out the force applied by the finger to the bowling ball. (underlining added).

Examiner misstates the functional statement of claim 1, as appearing in paragraph c. The exact recitation of paragraphs c, d and e, are,

    said second surface for insertion into a finger hole of a  
    bowling ball against the interior wall of said finger hole and  
    for said second surface for insertion into a finger hole of a  
    bowling ball against the interior wall of said finger hole and  
    for receiving a force of said bowling ball when a bowler's  
    maximum force is applied by said finger pad to the bowling  
    ball, in releasing the bowling ball;  
    means for placing, connected to said finger pad shield  
    means, for placing said contact area in contact with said  
    finger pad; and wherein  
    said finger pad shield means is made of a rigid material  
    adapted to spread said force of said bowling ball over said  
    contact area of said first surface for reducing the pressure  
    over said contact area.

(underlining added to show part of claim apparently intended by Examiner).

Fowble does not disclose it is capable of performing the intended use, or does perform the intended use, recited as,

    to spread said force of said bowling ball over said contact  
    area of said first surface for reducing the pressure over said  
    contact area.

Fowble does not show a "contact area" or a capability to "spread the force of said

bowling ball," "when a bowler's maximum force is applied by said finger pad to the bowling ball, in releasing the bowling ball," "over said contact area. The plain meaning of "over" is its ordinary accepted meaning of "all through" or "throughout." See Webster's New Collegiate Dictionary G. & C. Merriam Company, Springfield, Massachusetts, 1973, page 817, definition of "over" as a preposition. Specification, page 5, lines 10-14, page 8, lines 1-10. While Fowble may be capable of spreading some of the force against the protector , Fowble does not show a capability or structure as defined by the functions recited for the means of claim 1 and in particular, of spreading the force over said contact area. If the device of Fowble were to be use in place of the claimed invention, the structure of Fowble could deform and localize the force against the protector to a smaller area then the "contact area" and within the "contact area," and not over the claimed contact area.

#### IV. (Argument No.4)

Argument No. 4; Reference Issue No. 4, Claims 6-8 and 24-16, can be rejected under 35 U.S.C. 103 as unpatentable over Fowble in view of Pratt., for the grounds asserted by Examiner in Paper No. 8, Paragraph 4

Claims 6-8 and 24-26, are rejected as obvious over Fowble in view of Pratt under 35 U.S.C. 103. Examiner has failed to meet the basic requirements of a *prima facie* case of obviousness under 35 U.S.C. 103, as set forth in MPEP § 2343 et seq. This ground of rejection has no basis in Fowble because, Fowble does not show or disclose any part of the Claims 6-8, dependent on Claim 1 (amended) or any part of claim 24-26, dependent on claim 21 or on claim 19 as amended after Final Rejection, or the use of the device of

Fowble in a glove or in any context connected with bowling. This ground of rejection has no basis in Pratt because Pratt is not connected with or used in the context of, bowling. Pratt is for use by one handling coins, such as a gambler who need a flexible insert to provide a resilient contamination barrier for protection when picking up coins. The use of the insert of Pratt is for picking up coins and must be flexible while providing a barrier. The device of Fowble is for a surface hard enough to resist abrasion, unlike Pratt which is not concerned with abrasion but with a flexibility adequate to pick up coins. Pratt does not teach, show, disclose or suggest, any of the recited elements in Claims 6-8, dependent from Claim 1, and is inapplicable to these Claims. Applicant recited elements in Claims 6-8 are not shown in Pratt or Fowble and this ground of rejection is deficient in fact and law.

The disclosures of Fowble and Pratt are opposite, as Pratt's device must use flexible finger protectors to be able to pick up coins which Fowble's device is not concerned with picking up coins but in protection from abrasion from rough building materials. These are two separate objects which are taught separately and not suggested for combination in any one for the other and there is no teaching, disclosure or suggestion sufficient in Fowble or Pratt, to make a *prima facie* case of obviousness.

#### V. (Argument No. 5)

Argument No. 5; Reference to Issue No. 5, Claims 16-17, 19-21, 27-31, cannot be rejected under 35 U.S.C. 102(b) as anticipated by Marinese, for the grounds asserted by

Examiner in Paper No. 8, Paragraph 6

Examiner has not provided a copy of Marinese or stated the Marinese Patent

number. For the purpose of this Appeal Brief, Examiner is understood to mean Patent 3,046,561.

Marinese is protective thumb ring limited to the use of protecting the thumb, col. 1, lines 63-65; col., 3, lines 33-43. There is nothing disclosed in Marinese meeting the means plus function recitations of any of the listed claims 16-18, or 31. Examiner's statements that,

- a) claims 16, 19, 31 and 32(sic) are clearly shown,
- b) Marinese is inherently capable of from (sic) the maximum force developed by a bowler as called for in claims 17, 18, and 20,
- c) Marinese is rigid as called for in claim 21,

are conclusions without any facts referring the alleged elements of Marinese to the recited elements in the claims. The reason Examiner has not shown the elements in Marinese, as required for a rejection under 102(b) is because those elements do not exist in Marinese. Examiner has the burden under 102(b) of showing the recited element in Marinese and has not met that burden, under the APA Standard.

There is nothing in Marinese disclosing a "wall 3 extends obliquely to limit the depth of insertion...", or "wall part 3 is considered to be a raise surface, or "element 7 is considered a support..." Those statements is nothing more than Examiner using hindsight in reading uses or functions into Marinese which are not disclosed or inherent therein but are recited in the claims on appeal.

#### VI. (Argument No. 6)

Argument No. 6: Reference Issue No. 6, Claims 24-26 cannot be rejected under 35 U.S.C. 103 as unpatentable over Marinese in view of Pratt, for the grounds asserted by

Examiner in Paper No. 8, Paragraph 7

Claims 24-26, are rejected as obvious over Mariese in view of Pratt under 35 U.S.C. 103. Examiner has failed to meet the basic requirements of a *prima facie* case of obviousness under 35 U.S.C. 103, as set forth in MPEP § 2343 et seq. This ground of rejection has no basis in Marinese because, Marinese has not been shown by Examiner and in fact does not show or disclose, any recitations of the claims 24-26, dependent on claim 19, or of claim 19. This ground of rejection has no basis in Pratt because Pratt is not connected with or used in the context of, bowling. Pratt is for use by one handling coins, such as a gambler who need a flexible insert to provide a resilient contamination barrier for protection when picking up coins. The use of the insert of Pratt is for picking up coins and must be flexible while providing a barrier. The device of Marinese is a thumb protector protecting the thumb from abrasion when removed from a bowling ball, unlike Pratt which is not concerned with protection from abrasion but with a flexibility adequate to pick up coins.

These are two separate objects which are taught separately and not suggested for combination in any one for the other and there is no teaching, disclosure or suggestion sufficient in Marinese or Pratt, to make a *prima facie* case of obviousness. This ground of rejection is deficient in fact and law.

By this Appeal Brief, Appellants have responded to, and traversed, each and every ground of rejection asserted by the Examiner. Appellants cannot be made responsible for objections or rejections of Examiner and not articulated in his final rejection, Paper No. 8.

Respectfully Submitted,  
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